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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/961,084	10/30/97	KRONGAUZ	V 240606

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IM22/0717

EXAMINER

BERMAN, S

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 07/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/961,084

Applicant(s)

KRONGAUZ ET AL.

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19, 27, 29 and 31-49 ^{SB} is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 27, 29 and 31-49 ^{SB} is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Response to Amendment/Arguments

Applicant has amended the claims to recite the dielectric dissipation factor of the composition **after cure**. This recitation is considered to recite an inherent property of prior art compositions comprising the same components as are set forth in the instant claims, in the absence of any evidence to the contrary. Therefore, the rejections of record are maintained. The amendment of claim 29 to clarify the adhesion promoter overcomes the rejection under 35 USC 112.

Applicant's arguments filed 02-21-01 have been fully considered but they are not persuasive. Applicant's claims are drawn to a composition comprising the components set forth in the instant claims. The cited prior art teaches compositions comprising components corresponding to those in the instant claims. The difference in intended use of the compositions in the prior art and in the instant application does not confer patentability to the compositions. The properties of the compositions disclosed in the prior art and corresponding to the instantly claimed compositions would be expected to provide the same properties **when cured**, in the absence of evidence to the contrary.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19, 27, 29 and 31-⁵³~~49~~ are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compositions (A) comprising component (a) as set forth in claim 27, component (b) that 5-50% by weight (of the total weight of the composition) of a polyacrylated alkyl monomer, component (c) that is a (meth)acrylate ester of phosphoric acid, component (d) that is 1.0 to 10.0 % by weight of a phenyl ketone photoinitiator and component (d) that is 5-50 % by weight (of the

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total weight of the composition) of a monofunctional alkyl (meth)acrylate monomer and/or a N-vinyl or a vinyl ether functional diluent or (B) compositions set forth in Table 1 or table 2 in the instant specification, which compositions, after cure, have a dielectric dissipation factor at 60 Hz and 150 C of lower than about 0.2 or 0.05, does not reasonably provide enablement for all compositions comprising components a-e having said property. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. See pages 8-14 and tables 1 and 2. There is no disclosure of others kinds of "polyfunctional diluents", "acidic adhesion promoters", "light sensitive generating compounds" or "monofunctional diluents" suitable for providing the recited properties.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19, 27, 29 and 31-⁵³~~49~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 801 041. The rejection is set forth in paper number 20, pages 3-4.

Claims 19, 27, 29 and 31-⁵³~~49~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Shustack (5,352,712) in view of EP 0 801 041. The rejection is set forth in paper number 20, pages 4-5.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Berman whose telephone number is (703) 308-0040.

The fax number for this group is (703) 872-9310 or, for submissions after Final Rejection, (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service telephone number (703) 306-5665.

S B
7/16/01



Susan Berman
Primary Examiner
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